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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/338,729      | 06/23/1999  | DENNIS GROSS         | 10853/1             | 1761             |

26646 7590 07/01/2002

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| EXAMINER |
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BERMAN, ALYSIA

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| ART UNIT | PAPER NUMBER |
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1617

DATE MAILED: 07/01/2002 16

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/338,729

Applicant(s)

GROSS, DENNIS

Examiner

Alysia Berman

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-- Th MAILING DATE of this communication appears on th cover sheet with th correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 06 May 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) 1-9,27-30,34 and 35 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10-26,31-33 and 36-46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 6, 2002 has been entered.

2. Claims 1-46 are pending. Claims 10, 16, 37, 40, 41, 44, 45 and 46 have been amended. Claims 1-9, 27-30, 34 and 35 are withdrawn as directed to a non-elected invention in the Office Action mailed June 5, 2001, paper no. 8. The status of claims 10-26, 31-33 and 36-46 are as follows.

#### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 16-26, 31-33, 36, 41, 42 and 46 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification does not appear to provide a written description of a consistency of the compositions so that the compositions are not rinsed off of the skin.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter that the applicant regards as his invention.

6. Claims 16-26, 31-33, 36, 41, 42 and 46 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. The claims are vague and indefinite because it is unclear what consistency the compositions need to be so that they are not rinsed off of the skin. Neither the specification nor the claims provides any guidance of what consistency is suitable for this purpose. The metes and bounds of the claims cannot be determined.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. The claims are drawn to a kit comprising

a. A first composition having a pH between about 2.5 and about 4 comprising

i. An acid suitable as a skin renewing acid,

b. A second composition having a pH greater than about 7 to about 12 comprising

ii. an alkaline agent suitable for skin care compositions and

iii. about 0.1-10% of at least one surfactant/emulsifying agent, and

c. A means for applying the first and second compositions,

and a method of applying the first and second compositions to the skin.

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10. Claims 10-21, 24-26, 31-33, 36, 37, 39, 40 and 43-46 are rejected under 35 U.S.C. 102(b) as being anticipated by US 5,720,949 (949).

US '949 discloses a cosmetic mask comprising a first composition and a second composition that are applied sequentially to the face. One of the compositions comprises an acid and the other comprises an effervescent agent (abstract). The effervescent agent is preferably sodium bicarbonate and the acid is an alpha-hydroxy acid such as lactic acid (col. 2, lines 35-38). The acid component makes up about 1-30% of the second composition (col. 3, lines 61-67). Lactic acid has an inherent molecular weight of about 90. The compositions may be applied using a spatula or any other convenient applicator (col. 2, lines 42-47).

The effervescent composition may comprise from about 1-20% of a surfactant system (col. 3, lines 31-33). Surfactants such as cetareths, ceteths, laneths, nonoxynols, octoxynols, glyceryl stearate, PEG-castor oil, poloxamers, poloxamines and steareths are disclosed at column 5, line 47 to column 6, line 35. US '949 discloses ethoxylated sorbitan esters with fatty acids or alcohols and ethoxylated esters having preferably 14-18 carbon atoms, which encompass polysorbate-20 (col. 5, line 60 to col. 6, line 4).

The pH of the effervescent composition is from above 7.5 to about 9, preferably between 7.8 and 8.3 (col. 7, lines 58-60). The pH of the acid composition is from about 3.5 to about 6 (col. 8, lines 50-64). As a further note, pH is an inherent property of an acid or alkaline agent. Therefore, the pH of a composition comprising an acid or an alkaline agent is inherently either acid or basic, respectively, unless specifically altered.

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For additional suitable acids, see column 9, lines 8-13. See Example 1 at column 12 for one composition comprising 5.0 wt.% sodium bicarbonate, 1.5% glyceryl stearate, 5.0% cetyl alcohol, 1.5% PEG-100 stearate and 1.5% PEG-40 castor oil with a pH of 8.0 and another composition comprising 9.1% lactic acid with a pH of 4.9. The reference teaches at column 13, lines 7-9, that the composition bubbles because of the reaction between the effervescent agent and the acid. This is interpreted as meaning that the alkaline, effervescent agent neutralizes the acid component.

Claims 16-21, 24-26, 31-33, 36, and 46 are directed to a product. Any properties exhibited by the product are inherent. Applicant has not provided any limitations in the claims to distinguish the first and second compositions of the instant invention from the compositions of the prior art. The compositions of the prior art containing the same components as instantly claimed inherently exhibit the same properties. A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. *In re Spada*, 911 F.2d 705, 709, 15 USPQ 1655, 1658 (Fed. Cir. 1990). See MPEP §2112.01. The burden is shifted to Applicant to show that the prior art product does not inherently possess the same properties as instantly claimed product.

### ***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 10-22, 24-26, 31-33, 36, 37, 39, 40 and 43-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,720,949 (949).

US '949 discloses all of the limitations of the claims as stated in the 35 U.S.C. 102(b) rejection above. It does not disclose octoxynol-9 (claim 22). US '949 discloses at column 6, line 18 that octoxynol-7, octoxynol -10 and octoxynol -14 are all suitable surfactants. Octoxynol-9 is a known surfactant. It is within the skill in the art to substitute one known octoxynol surfactant for another, especially when the difference is only one or two ethoxy groups, and expect similar results.

It would have been obvious to one of ordinary skill in the art at the time of the invention to substitute octoxynol-9 for the octoxynol surfactants disclosed in US '949 with the reasonable expectation of obtaining the same emulsification effects.

13. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,720,949 (949) as applied to claims 16-22, 24-26, 31-33, 36 and 46 above and further in view of US 4,797,273 (273) and Database REGISTRY on STN for polysorbate-20.

US '949 teaches all the limitations of the claims as stated as stated in the 35 U.S.C. rejections above. It does not disclose polysorbate-20. US '273 teaches that polysorbate-21, which is equivalent to polysorbate-20 as evidenced by the REGISTRY file printout for polysorbate-20 obtained on STN, is a known surfactant for use in skin care compositions (col. 6, lines 14-18).

It would have been obvious to one of ordinary skill in the art at the time of the invention to prepare the composition of US '949 using polysorbate-20 as taught by US '273 expecting to obtain an emulsified composition.

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14. Claims 38, 41 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,720,949 (949) as applied to claims 16-22, 24-26, 31-33, 36 and 46 above, and further in view of US 5,242,433 (433).

US '949 discloses all of the limitations of the claims as stated as stated in the 35 U.S.C. rejections above. It does not disclose using a pad as an applicator for the compositions. US '433 discloses a packaging system of applicator pads for topical drug delivery and a method of applying two dermatological agents to the skin sequentially using the applicator pads (title and abstract).

It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the compositions of US '949 in a packaging system with a pad applicator as taught by US '433 expecting to provide a convenient means of dispensing a plurality of substances, overcome the physical and chemical incompatibilities of the substances and allow for sequential application.

US '347 discloses a multi-component kit comprising a first composition a second composition with a pH of 1.8-6, which overlaps the instantly claimed pH ranges of the acidic composition. The second composition comprises an acid such as alpha-hydroxycarboxylic acids. See claim 18. See Examples 1.1-1.5 bridging columns 11 and 12 for a composition comprising sodium hydroxide, sodium lauryl ether sulfate and ammonia and stripper gel compositions comprising ascorbic acid, *inter alia*. US '347 discloses an applicator at column 11, lines 64-65. The pH value of the first composition is preferably from 5 to 9 (col. 9, lines 7-8). This either overlaps or encompasses the instantly claimed pH ranges of the alkaline composition. US '347 discloses at column 9,



lines 14-16 that buffers such as alkali carbonates can be added to the compositions. For surfactant/emulsifiers, see column 8, lines 52-57.

US '347 does not teach applicator pads. US '433 discloses a packaging system of applicator pads (title and abstract).

It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the compositions of US '347 in the packaging system of US '433 expecting to provide a convenient means of dispensing a plurality of substances, overcome the physical and chemical incompatibilities of the substances and allow for sequential application.

### ***Response to Arguments***

15. Applicant's arguments filed May 6, 2002 have been fully considered but they are not persuasive.

16. Applicant argues that the compositions of US '949 are not of a consistency that they would not be rinsed off and that makeup can be applied without rinsing off or removal of the compositions. It is noted that the claims do not recite that the compositions cannot be removed, only that they are of a consistency that they are not rinsed off. The claims are directed to a product. Any future intended use of that product such as application to the skin where the compositions are not rinsed/removed or application of makeup after application of the compositions does not provide patentability to the claims. Further, the claims are not limited to a specific consistency. Applicant has not provided any guidance in the claims or the specification of what is a suitable consistency as instantly claimed. The compositions of US '949 are not rinsed

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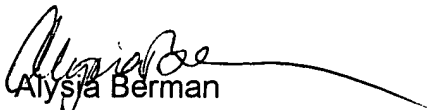
off and, therefore, appear to be of a consistency that they are not rinsed off as instantly claimed. Applicant has not provided any evidence of record that the compositions of US '949 are not of a suitable consistency so that they are not rinsed off or that makeup cannot be applied without rinsing off the compositions.

***Correspondence***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alysia Berman whose telephone number is 703-308-4638. The examiner can normally be reached Monday through Friday between 9:00 am and 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Minna Moezie, can be reached on 703-308-4612. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 or 703-872-9307 for after-final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234 or 703-308-1235.

  
Alysia Berman  
Patent Examiner  
June 21, 2002

  
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